

### **REMARKS**

The Final Office Action dated May 2, 2006 contained a final rejection of claims 1-16. The Applicant has amended independent claims 1, 7, 8, 9, 15, and 16. Claims 1-16 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Final Office Action rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Howard (U.S. Patent Publication No. 2005/0091109) in view of Applicants' Background of the Invention and further in view of Blaser (U.S. Patent No. 6,757,661).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

Specifically, the combination of Howard with the Applicants' Background of the Invention and Blaser does **not** disclose all of the Applicants' amended claims. For example, the combined references disclose a system for distributing customized publications, including customized advertising and customized content (see Abstract of Howard), increasing subscribers is a top priority (see Background) and ad server for selecting advertisements to be viewed by users of an online service based upon user activity (see col. 9 through col. 10 of Blaser).

In contrast, **none** of cited references, in combination or alone, disclose the Applicants' newly added features of automatically tracking publication distribution to various recipient subscribers, including recording times during the day that the subscriber requests files of the publications and determining the subscriber's publication usage levels from data in said user profile, the recorded times, the files that the subscriber requested, whether the subscriber requested a download of particular known type of file and the automatically tracked publication distribution, wherein the data includes historical data on the subscriber's usage of on-line publications.

Although Blaser disclose a system that monitors user activity, compares the activity to identifiers in a targeted activity list, and displays targeted advertisements if the activity matches one of the identifiers (see col. 9 through col. 10 of Blaser), Blaser in combination

with the other cited references is still **missing** the Applicant's automatically tracking publication distribution to various recipient subscribers, which includes recording times during the day that the subscriber requests files of the publications and determining the subscriber's publication usage levels from the recorded times, the files that the subscriber requested and whether the subscriber requested a download of particular known type of file.

In addition, the Examiner is reminded that these references and the Applicant's Background **should not** be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Namely, hindsight should not be used to improperly conclude that the Applicant's Background "...provides the motivation of why Howard's electronic publisher would determine a subscriber's usage level from the consumer's profile to better target advertisements...similar to Applicant's claimed invention." This is because in light of the amendments to the claims, the Applicant submits that the claimed invention now includes recording times during the day that the subscriber requests files of the publications and using the recorded times, the files that the subscriber requested and whether the subscriber requested a download of particular known type of file determining the subscriber's publication usage level, which is **not** disclosed, taught or suggested by the combined cited references.

Further, even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Consequently, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001,

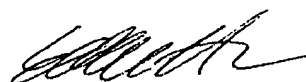
1008 (Fed. Cir. 2001). [emphasis added]. Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicants' invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on at least the same basis. (MPEP § 2143.03).

In view of the arguments and amendments set forth above, the Applicants respectfully submit that the rejected claims are in immediate condition for allowance. The Examiner is therefore respectfully requested to withdraw the outstanding claim rejections and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,  
Dated: August 2, 2006



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